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PAPER NO. 16

[NChan Art Unit 123
304,481 9/22/81]
Gabrijela Kobrehel, et al]

Before the Board of Appeals

11-METHYL-11-AZA-4-O-
CLADINOSYL-6-O-DESO-
AMINYL-15-ETHYL-7,13,14-
etc.

Pollock, Et. Al.
For Appellants

Examiner's Answer

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SLP 17 1984

BOARD OF APPEALS

This is an appeal from the final rejection of claims 3-11. Claim 2 stands allowed and claim 23 has been withdrawn from appeal by appellant.

A correct copy of the claims appears in the brief at pages 1-2.

REFERENCE OF RECORD RELIED ON

Kobrehel et al 4,328,334 5/4/82 (filed on 3/28/80)

DESCRIPTION OF THE REFERENCE

Kobrehel et al teaches 11-aza-10-deoxo-10-dihydro-erythromycin A and derivatives thereof useful as anti-

bacterial agents. The reference compounds differ from the instant compounds only in the N-methyl group attached to the ring nitrogen atom.

The invention is adequately described in the brief at page 2.

THE REJECTION

Claims 3-11 stand rejected under 35 USC 103 as unpatentable over Kobrehel et al. The instantly claimed compounds differ from the reference compounds only in one single methyl group attached to the ring nitrogen atom. However, it has been well settled that adding a methyl group to a prior art compound is an obvious modification. See In re Paquette, 165 USPQ 317, 319.

RESPONSE TO APPELLANT'S ARGUMENTS

The reference discloses antibacterial compounds differing from those instantly claimed by the absence of a methyl group on the ring nitrogen atom. N-methylated compounds have been held to be obvious modification of the corresponding unsubstituted nitrogen containing compounds. In re Paquette, 165 USPQ 317, 319.

Accordingly, the claimed compounds are prima facie obvious over the reference compounds and appellant has tacitly acquiesced to this holding of obviousness.

Appellant relies on the declaration filed February 17, 1984 and Tables 1 and 2 on pages 5-6 of the specification to show superior properties of the claimed compounds.

The results in the declaration are in favor of the compound N-methyl-11-aza-10-deoxo-10-dihydro-erythromycin A. Accordingly, claim 2 has been allowed and is not included in this appeal. The declaration also discloses data of the 13, 14-cyclic carbonate of the above compound. However, since this latter compound was not compared with the reference carbonate of compound VI, the data has not been given much probative weight. Any side-by-side comparisons must be with the closest prior art compounds. Therefore, the cyclic carbonate of the claimed N-methyl compound must be compared with the cyclic carbonate of the reference unsubstituted nitrogen compound.

Appellant urges that since the data disclosed in the reference showing that the reference unsubstituted nitrogen compound (11-aza-10-deoxo-dihydroerythromycin A) is somewhat superior to the corresponding 13, 14-cyclic carbonate, it would be reasonable to attribute

any improved results to the presence of the N-methyl substituent. However, before one attempts to make a generalization, one must first make sure that all available data has been considered. Appellant has not done this.

Tables 1 and 2 on pages 5-6 of the specification compare the compounds of appealed claims 3-11 as well as allowed claim 2. In Table 1, compounds 2, 3, 5 and 6 correspond to the esters recited in claims 3-6, respectively. In Table 2, compounds 7-11 correspond to the cyclic carbonates recited in claims 7-11. The data shows that the claimed esters and cyclic carbonates are all inferior in antibacterial activities to the reference unsubstituted nitrogen compound (11-aza-^{10-deoxo-}10-dihydroerythromycin A). Furthermore, below Table 1, it is disclosed that the compound of Example 4 (the 2',4",13-triacetyl compound of formula (1)) "did not exhibit any satisfactory activity" in the test.

The data in Tables 1 and 2 put to rest any notion that the N-methyl substituent contribute to the improved antibacterial activities of the claimed compounds. On the contrary, the data shows that the reference 11-aza-10-deoxo-10-dihydroerythromycin A is superior to the claimed N-methylated, esterified and carbonated derivatives.

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Accordingly, it is submitted that the rejection is sound and the decision of the Examiner should be affirmed.

Respectfully submitted,

NChan:ebw

A/C 703

557-3920

8/2/84

A handwritten signature in cursive script, appearing to read "Nicky Chan", with a horizontal line underneath.

NICKY CHAN
PRIMARY EXAMINER
ART UNIT 123

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